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"PATENT APPLICATION"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re Application of

MAURO GELLI ET AL

APPEAL No.

U.S. Serial No. 10/566,629

Group Art Unit 1746

Filed: March 9, 2006

B. Musser, Examiner

METHOD AND DEVICE TO PRODUCE AN
EMBOSSED AND PRINTED PRODUCT AND
PRODUCT THEREBY OBTAINED

Alexandria, Virginia
February 22, 2011

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer mailed December 21, 2010 in order to respond to new points of argument raised by the Examiner and to avoid acquiescence in the position of the Examiner.

Applicants submit that neither the claimed methods nor the teachings of the applied references are being considered as a whole. It is believed that features in isolation are being considered as opposed to the combination claimed and that the teachings of each reference are not being considered as a whole, but rather based on applicants'

teaching. In application of 35 U.S.C. §103, the teachings of a reference must be considered as a whole and each and every element of the claim must be taught or suggested by the applied references. Whether by teaching or suggestion, a firm factual basis must be provided and not simply speculation.

More particularly, with reference to the independent claims 44 and 91, the claimed methods of producing an embossed web material of at least two plies coupled to each other by glue involves a combination of specified steps. A first ply is embossed to produce a first series of protuberances forming a background pattern. Ink is applied to at least some of the protuberances of this first series to provide a colored pattern. Subsequently, the same ply is further embossed to produce a second series of protuberances which have a greater height and lesser density than the protuberances of the first series. This second series of protuberances provides a decorative motif also in the first ply. Glue is applied to at least some of the protuberances of the second series. A second ply is then adhered to the first ply by means of the glue applied to protuberances of the second series. Claim 91, in addition to the above, further provides that the protuberances of the first series have an average density

ranging from 20-100 protuberances/cm² and that the glue is colored.

It is respectfully submitted that the Examiner is considering each of the claimed methods and the applied references from the standpoint of isolated features present therein as evident from the "Response to Argument" as set forth in the Examiner's Answer.

For example, the Examiner asserts that there are only two choices for which ply to apply adhesive and further asserts that the claims do not actually require the adhesive to be applied. First, the claims specifically call for "applying a glue to at least some of the protuberances of said second series of protuberances". Further, it is the combination of features which must be taken into consideration not the isolated feature of glue application. As set forth in applicants' Appeal Brief filed October 18, 2010 (and supplemented re "Status of Amendments" on November 18, 2010) and relied on here, when the teachings of Biagiotti and Ruppel are considered as a whole, Ruppel would not be looked at by one skilled in the art for combination with Biagiotti to obtain applicants' claimed methods in view of specific teachings therein. The Examiner states that Ruppel is not being modified but rather Biagiotti is being modified. Applicants submit that in view of the specific

teachings of Ruppel, as set forth in the applicants' Appeal Brief, to modify Biagiotti to obtain applicants' claimed methods, Ruppel would also require modification in view of the specific teachings therein and lack of teachings in Biagiotti and Ruppel. One skilled in the art would act within the teachings as taught in Ruppel absent some other suggestion which is not present in the instant case in either Ruppel or Biagiotti. The Examiner acknowledges the shortcomings of Biagiotti and needs Ruppel to modify Biagiotti. But Ruppel is only considered as to isolated features described therein and not based on its teachings as a whole. When the teachings as a whole are considered as discussed in applicants' Appeal Brief, one skilled in the art would not provide applicants' combination of features as claimed. For example, the Examiner notes that applicants' arguments refer to the textile effect achieved but further notes that such is not claimed. This is incorrect since the textile effect results from a combination of claimed features, such as the first ply including a background pattern based on a first series of protuberances and a decorative motif provided by a second series of protuberances of greater height and lesser density than the first series of protuberances. The Examiner states that the entire device of Ruppel is not to be placed in the device of

Biagiotti. In such instance, it is even more critical to look to the specific teachings of the applied reference to determine if suggestion is present to select an isolated feature and use it for application in a different manner.

Contrary to the Examiner's assertion, there are a myriad of choices as to providing different combinations of protuberances as to pattern, size, density, etc. and the application of glue and/or ink as clearly evident from consideration of the numerous embossing methods described in the art. This shows the criticality in consideration of the specific teachings of the art, e.g. Ruppel with regard to the disadvantages in the art sought to be avoided and the manner in which that was achieved. Otherwise all embossing combinations could be said to have a finite number of solutions based on having a finite number of plies and particular elements and, therefore, all variations could be considered simply obvious to try. But this is clearly not the case since new combinations are possible, such as applicants' claimed method which provides, for example, a textile effect based on the combination of embossing in one ply first and second series of protuberances having different heights and densities in relation to each other, and the manner of application of ink and glue thereto followed by the manner of adherence of a second ply to the

first ply. The Examiner's arguments in the Examiner's Answer rely repeatedly on the assertion that there are only a finite number of choices as to various features, e.g., page 5 as to adhesive application, page 6 as to pattern choices, page 7 as to glue. This does not take into account the myriad of combinations available using the different isolated features, including applicants' claimed combination.

As held by the Court of Appeals for the Federal Circuit, a combination may be patentable whether it be composed of elements all new, partly new or all old.

Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1546; 221 USPQ 1, 7 (Fed. Cir. 1984). Obviousness or nonobviousness is based on the "making of the combination" in the first instance. Beatrice Foods Co. v. Tsuyama Mfg. Co., 619 F.2d 3, 7; 204 USPQ 889, 893 (CA7 1979).

In the present instance, a factual basis is missing for picking and choosing the isolated features from the applied references and using these isolated features together in a combination as claimed. Applicants are claiming a specific combination of features. The art does not provide this combination or recognize any criticality as to the specific features in order to suggest a combination as claimed.

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Accordingly, applicants respectfully request
reversal of the rejection of the claims.

Respectfully submitted,

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